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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/998,302 12/24/97 STANFIELD

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EXAMINER

ZIMMERMAN, R

ART UNIT

PAPER NUMBER

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/998,302

Applicant(s)

Stanfield

Examiner

Brian A Zimmerman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

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Status of Application.

1. The examiner has considered the new presentation of claims and applicant arguments in view of the disclosure and the present state of the prior art. And it is the examiner's position that claims 1-63 are unpatentable for the reasons set forth in this office action:

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-6, 11-14, 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (5455409) and either Gillotte (5424858) or Kott (4376936).

Smith shows a file tracking system in which a processor is connected to a bus which is connected to a folder retainer 12. The processor gets requests from an input device (col. 5 line 55 to col. 6 line 10) and sends information to a folder such that a indicator displays the ^{location}lactation of the folder to a user requesting to know the location of the folder. Smith discloses that the use of a data base to maintain the location information is an alternative to the distributed database system. It is pointed out that Smith does in fact disclose the use of a central database in a file retrieval system, however Smith chooses not to utilize such a database. Smith uses polling to determine the location of the files. See abstract. From this suggestion, the skilled artisan would reliably be able to efficiently update and manage a database of information.

In an analogous art, Kott shows a file folder which is placed in a file retainer and communicates with the retainer via a conductive bus. The file includes conductors on the file folder configured to couple the folder to a retainer. It is clear that Kott shows a file with a conductor located on the surface of the file. Kott also shows a retainer with rails to suspend the file and provide a data communication as well as a ground. Kott's folder has the contacts on the side and edge of the surface of the folder. Kott includes an indicator on the file. Kott shows the files could be located on a plurality of shelves (col. 4 line 29). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the folder of Kott to store documents information in a filing system which can communicate to the folders in the manner suggested by Kott since such would provide the cheap communication with the file.

In an analogous art, Gillotte also shows a file folder which is placed in a file retainer and communicates with the retainer via a conductive bus. The file includes conductors on the file folder configured to couple the folder to a retainer. Gillotte includes an indicator on the file. It is clear that Gillotte shows a file with a conductor located on the surface of the file. Gillotte also shows a retainer with rails to suspend the file and provide a data communication as well as a ground. Gillotte's folder has the contacts on the side and edge of the surface of the folder. Gillotte shows the files could be located on a plurality of shelves (col. 2 line 37). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the folder of Gillotte to store documents information in a filing system which can

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communicate to the folders in the manner suggested by Gillotte since such would provide the cheap communication with the file.

The references above show the use of LEDs as indicators to assist in locating the file. The examiner takes official notice that activating an LED with a transistor, in the manner claimed, is common practice for driving LEDs.

3. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, Gillotte and Kott as applied to claim 1 above, and further in view of Foster (5287414).

In an analogous art, Foster shows a file locating system which includes a PC 24 to record and display the location of the files. This provides assistance to the user in determining the location of a desired file. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used a PC for storing and displaying the location of a desired file, since such would assist the user in determining the location of a desired file.

4. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, Gillotte, Kott and Foster as applied to claims 1 and 7 above, and further in view of Doyle (5426284).

In an analogous art, Doyle shows a file locating system which includes a computer (figure 2). The computer includes links 216 and 220 for communicating to other computers. The examiner takes official notice that the use of a LAN to connect

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computers is very common in the art of computer networks, and as such would have been verily obvious to one of ordinary skill at the time of the invention.

5. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, Gillotte, Kott as applied to claims 1 and 12 above, and further in view of the Dallas Semiconductor publication "Touch the Future."

The article shows the use of trays for holding objects that are to be located. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized a tray for holding and communicating with files in the manner suggested by the above modified system since such would provide increased locating abilities.

6. Claims 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, Gillotte, Kott as applied to claims 1 and 12 above, and further in view of Kott.

Kott shows the positioning of the communication rails on the side of the file drawer. See figure 3 and col. 4 line 29.

7. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, Gillotte, Kott as applied to claims 1 and 12 above, and further in view of Leighton (3701987).

Leighton shows the positioning of the communication rails on the bottom of the file drawer. See figure 4. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized communication rails on the bottom of the drawer of the above modified system to provide an equivalent communication to the files.

8. Claims 19-45,47-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (5455409) and Kott (4376936) and either Wakura (5063380) or Kubota (UK 2279789).

Smith shows a file tracking system in which a processor is connected to a bus which is connected to a folder retainer 12. The processor gets requests from an input device (col. 5 line 55 to col. 6 line 10) and sends information to a folder such that a indicator displays the location of the folder to a user requesting to know the location of the folder. Smith discloses that the use of a data base to maintain the location information is an alternative to the distributed database system. It is pointed out that Smith does in fact disclose the use of a central database in a file retrieval system, however Smith chooses not to utilize such a database. Smith uses polling to determine the location of the files. See abstract. From this suggestion, the skilled artisan would reliably be able to efficiently update and manage a database of information.

In an analogous art, Kott shows a file folder which is placed in a file retainer and communicates with the retainer via a conductive bus. The file includes conductors on the file folder configured to couple the folder to a retainer. It is clear that Kott shows a

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file with a conductor located on the surface of the file. Kott also shows a retainer with rails to suspend the file and provide a data communication as well as a ground. Kott's folder has the contacts on the side and edge of the surface of the folder. Kott includes an indicator on the file. Kott shows the files could be located on a plurality of shelves (col. 4 line 29). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the folder of Kott to store documents information in a filing system which can communicate to the folders in the manner suggested by Kott since such would provide the cheap communication with the file.

In an analogous art, Wakura shows a file locating system which includes a central computer that sends request to locate files to cabinets 10 (figure 4). Each cabinet is in communication with the files it is currently storing, and has a display on the computer and the cabinet to assist the user in finding the located file. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the distributed scheme suggested by Wakura in the above modified system in order to assist the user in finding the located file.

In an analogous art, Kubota shows a file locating system which includes a central computer that sends request to locate files to cabinets 10,11,12 (figure 2). Each cabinet is in communication with the files it is currently storing, and has a display on the computer 4 and the cabinet to assist the user in finding the located file. The computer 1 is also connected to other processors 6,7,8 via a local area network 5. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to

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have utilized the distributed scheme suggested by Kubota in the above modified system in order to assist the user in finding the located file.

9. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, Kott, Wakura and Kubota as applied to claim 43 above, and further in view of Warren (5398919).

In an analogous art, Warren teaches the use of a permission list to authorize the user to access the located file. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized a permission list to authorize the user to use the above modified system since such would increase security.

10. Claim 58 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, Kott, Wakura and Kubota as applied to claims 1 and 12 above, and further in view of the Dallas Semiconductor publication "Touch the Future."

The article shows the use of trays for holding objects that are to be located. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized a tray for holding and communicating with files in the manner suggested by the above modified system since such would provide increased locating abilities.

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 34-38 and 53 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S.


Patent No. 5751221 in view of Smith, Kott, Wakura and Kubota. The teachings of these references are discussed above. The particular folder and retainer claimed are already covered by the claims in 5751221. To allow the pending claims would improperly extend the patented invention. To have used the particular file arrangement from the patent in the above modified system would have been obvious since it is merely an equivalent to the cabinets in the references.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian A Zimmerman whose telephone number is 703 305-4796. The examiner can normally be reached on 7am to 4pm, every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 703 305-4704. The fax phone numbers for the organization where this application or proceeding is assigned are 703 305-3988 for regular communications and 703 305-3988 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-4700.



Brian A Zimmerman
Primary Examiner
Art Unit 2635

BaZ
April 11, 2001